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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/666,889
Filing Date: September 17, 2003
Appellant(s): XUE, XIN

Jonathan O. Owens
Reg. No. 37,902
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/26/2010 appealing from the Office action mailed 10/01/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
Claims 1- 44.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2004/0103064 A1	Howard et al.	05-2004
2004/0010467 A1	Hori et al.	01-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (U.S. Patent Application Publication: 2004/0103064 A1) hereinafter Howard in view of Hori et al. (U.S. Patent Application Publication: 2004/0010467 A1) hereinafter Hori.

Regarding Claims 1 and 10, Howard discloses a method of downloading content from a server to an electronic device (Figure 1, elements 10, 30, and 40), comprising:

- storing authentication data on a removable memory (smart card 14) (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);
- accessing the server with the electronic device (Figure 1, elements 10, paragraph 0021);
- authenticating the removable memory by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026); and

downloading the content from the server to the PC (paragraph 0025) according to the predetermined level of content access (paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Hori expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 19, Howard discloses a system for downloading content (Figure 1), comprising:

- a removable memory (Figure 1, smart card 14), the removable memory including authentication data (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);

- an electronic device (Figure 1, element 10) configured to receive the removable memory (paragraph 0018); and

- a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when the electronic device accesses the server (paragraph 0021), the removable memory is authenticated by reading the authentication data from the removable memory

(paragraph 0020) and determining the predetermined level of content access (paragraphs 0022-0026), and further

wherein once authenticated (paragraph 0021), content according to the predetermined level of content access is downloaded from the server to the electronic device (Figure 1, elements 10 and 40, paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Hori expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 28, Howard discloses an electronic device (Figure 1, element 10) for downloading (Abstract), comprising:

a memory slot (Figure 1, card reader 12) configured to receive a removable memory (Figure 1, smart card 14), wherein the removable memory includes authentication data (paragraph 0020), the authentication data includes a predetermined level of content access (paragraphs 0022-0026); and

a communications interface configured for coupling to a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when the electronic device accesses the server through the communications interface (Figure 1, paragraphs 0018-0021), the removable memory is authenticated by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026),

further wherein content according to the predetermined level of content access is downloaded (Figure 1, elements 10 and 40, paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Hori expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 36, Hori discloses a removable memory (memory card 110/112) for downloading, comprising:

authentication data (paragraph 0020), the authentication data includes a predetermined level of content access (paragraphs 0022-0026)

a communications interface configured for coupling to a server (Figure 1, elements 30 and 40, paragraph 0022), wherein when an electronic device (Figure 1, element 10) accesses the server through the communications interface (Figure 1, paragraphs 0018-0021), the removable memory is authenticated by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026), further wherein the electronic device includes a memory slot (Figure 1, card reader 12) configured to receive the removable memory (Figure 1, smart card 14, paragraph 0018), and further

wherein content according to the predetermined level of content access is downloaded (Figure 1, elements 10 and 40, paragraphs 0022-0026), further wherein the predetermined level of content access determines how much of the content on the server is available for download (paragraph 0025), but fails to disclose downloading the content from the server to the removable memory.

However, Hori expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claim 44, Howard discloses a method of downloading content from a server to an electronic device (Figure 1), comprising:

storing authentication data on a removable memory (smart card 14) (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026);

accessing the server with the electronic device (Figure 1, elements 10, paragraph 0021);

authenticating the removable memory by reading the authentication data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026);

wherein the authentication data is time stamped, such that the predetermined level of content access is available for a predetermined amount of time (paragraphs 0022-0026); and

downloading the content from the server to the PC (paragraph 0025) according to the predetermined level of content access (paragraphs 0022-0026), but fails to disclose downloading the content from the server to the removable memory.

However, Hori expressly discloses downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent

distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010).

Regarding Claims 2, 11, 20, 29, and 37, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the authenticating is performed by the server (Howard, paragraph 0022 and Hori paragraph 0063).

Regarding Claims 3, 12, 21, 30, and 38, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the removable memory is a semiconductor memory (Howard, Figure 1, element 14 and Hori Figure 1, element 110, paragraph 0065).

Regarding Claims 4, 13, 21, 31, and 39, Howard and Hori disclose the limitations of Claim 1 above. Howard further discloses time stamping the authentication data, such that the predetermined level of content access is available for a predetermined amount of time (paragraphs 0022-0026).

Regarding Claims 5, 14, 23, 32, and 40, Howard and Hori disclose the limitations of Claim 1 above. Howard and Hori further disclose wherein the server is accessed through a wired internet connection, further wherein the wired internet connection includes a conduit and a personal computer (Howard, Figure 1, paragraph 0018 and Hori Figures 1 and 4).

Regarding Claims 6, 15, 24, 33, and 41, Howard and Hori disclose the limitations of Claim 1 above. Hori further discloses wherein the server is accessed through a wireless connection (Figure 1, paragraph 0076).

Regarding Claims 7, 16, and 25, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes an internet connection (paragraph 0071).

Regarding Claims 8, 17, 26, 34, and 42, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes a local area network (paragraph 0071).

Regarding Claims 9, 18, 27, 35, and 43, Howard and Hori disclose the limitations of Claim 6 above. Hori further discloses wherein the wireless connection includes a wide area network (paragraph 0071).

(10) Response to Argument

Claims 1- 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howard et al. (U.S. Patent Application Publication: 2004/0103064 A1) hereinafter

Howard in view of Hori et al. (U.S. Patent Application Publication: 2004/0010467 A1) hereinafter Hori.

Regarding independent Claims 1, 10, 19, 28, 36, and 44,

Appellant appears to argue that "1. Howard does not teach transferring content from a content server to a removable memory" (Page 7 of Remarks), "2. Hori does not teach the presently claimed invention" (Page 8 of Remarks), "3. The combination of Howard and Hori is improper because there is no motivation to combine the downloading of content from a server to a removable memory of Hori with the model relating to the payment for online content of Howard" (Page 8 of Remarks), "4. The combination of Howard and Hori is improper because it would change Howard's principle mode of operation" (Page 9 of Remarks), and "5. The claims distinguish over Howard, Hori and their combination" (Page 9 of Remarks).

This is not found persuasive because first of all, Howard discloses a method of downloading content (paragraph 0025, downloadable content) from a server (Figure 1, element 40) to an electronic device (Figure 1, elements 10), comprising: storing authentication data on a removable memory (smart card 14) (paragraph 0020), wherein the authentication data includes a predetermined level of content access (paragraphs 0022-0026); accessing the server with the electronic device (Figure 1, elements 10, paragraph 0021); authenticating the removable memory by reading the authentication

data from the removable memory (paragraph 0020) to determine the predetermined level of content access (paragraphs 0022-0026); and downloading the content from the server to the PC (paragraph 0025) according to the predetermined level of content access (paragraphs 0022-0026). Second, in the analogous art, Hori discloses a method of downloading content from server (Figure 1, element 30) to an electronic device (Figure 1, element 100) (paragraph 0065). Further, Hori explicitly discloses the step of downloading the content from the server to the removable memory (Figure 6, paragraphs 0065 and 0171). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include the step of downloading the content from the server to the removable memory. One of ordinary skill in the art would have been motivated to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Furthermore, Appellant's argument "there is no indication in Hori that downloading the content to the removable memory instead of the user PC" that is not persuasive because the claimed limitation only requires "downloading the content from the server to the removable memory" recited in claim 1. Moreover, Hori explicitly discloses the claimed feature in paragraph 0065 "Memory card 110 receives the encrypted content data and license through cellular phone 100." It is clear that this citation reads on the claimed limitation.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., downloading the content to the removable memory **instead of the user PC**) are

not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the content server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claims 1, 10, 19, 28, 36, and 44 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori is proper because they both specifically disclose how to download the content from the server by using the smart card for granting access to on-line content as taught by Howard and

downloading the content from the content server to the memory card for storing the content with copyright protection as taught by Hori with the motivation to allow the user to access the content on memory card with different terminals. It has been held that "the combination of familiar elements according to known methods is likely to be obvious when it does not more than yield predictable results" KSR., 127 S. Ct. at 1739, 82USPQ2d at 1395 (2007) (citing Graham, 383 U.S. at 12).

Furthermore, Appellant's argument "the combination of Howard and Hori is improper because it change Howard's principle mode of operation" that is not persuasive because as explained above, the combination of Howard and Hori is proper because they both specifically disclose how to download the content from the server by using the smart card for granting access to on-line content as taught by Howard and downloading the content from the content server to the remove card for storing the content with copyright protection as taught by Hori that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claims 1, 10, 19, 28, 36, and 44 that download content from the content server (Howard and Hori, Abstract). Therefore, the combination is proper because it would not change Howard's principle mode of operation.

a. Regarding Claims 1-9,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 1 is allowable over the teaching of Howard, Hori and their combination" (Page 10 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 1 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori for Claims 1-9 is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

b. Regarding Claims 10-18,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 10 is allowable over the teaching of Howard, Hori and their combination" (Page 10 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 10 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori for Claims 10-18 is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

c. Regarding Claims 19-27,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 19 is allowable over the teaching of Howard, Hori and their combination" (Page 11 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 19 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori for Claims 19-27 is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

d. Regarding Claims 28-35,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 28 is allowable over the teaching of Howard, Hori and their combination" (Page 11 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 28 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori for Claims 28-25 is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

e. Regarding Claims 36-43,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 36 is allowable over the teaching of Howard, Hori and their combination" (Page 12 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 36 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori for Claims 36-43 is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

f. Regarding Claim 44,

Appellant argues that "as described above, the combination of Howard and Hori is improper. For at least these reasons, the independent Claim 44 is allowable over the teaching of Howard, Hori and their combination" (Page 12 of Remarks).

Examiner disagrees with the Appellant's argument. As explained above, Howard's reference and Hori's reference are analogous arts. They both specifically disclose how to download the content from the server that can support the motivation to combine the Howard's teaching within Hori's teaching to establish the limitations of Claim 44 that download the encrypted data from the content server (Hori, Abstract). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated Hori's invention within Howard to include downloading the content from the server to the removable memory. One of ordinary skill in the art would have been to do so because it would prevent distributed copyrighted data from being replicated without permission of the copyright owner (Hori paragraph 0010). Therefore, the combination of Howard and Hori is proper because they both specifically disclose how to download the content from the server using the smart card to grants access to exclusive on-line content and download the content from the content server as taught by Howard and downloading the content from the content server to the remove card to prevent distributed copyright data from being replicated without permission of the copyright owner as taught by Hori. Thus the motivation is proper because it would provide copyright protection when the content is downloaded from the content server.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Bao tran N. To/

Examiner, Art Unit 2435

Conferees:

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435

/Nirav Patel /

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